
“THE DEVIL TAKE THE HINDMOST”: COPYRIGHT’S
FREEDOM FROM CONSTITUTIONAL CONSTRAINTS
AFTER *GOLAN v. HOLDER*

JESSICA W. RICE[†]

INTRODUCTION

In 1994, Congress enacted section 514 of the Uruguay Round Agreements Act (URAA),¹ which brought the United States into compliance with its obligations under the Berne Convention,² the primary accord governing international copyright relations. The effect of section 514 was to remove millions of previously uncopyrighted foreign works—including the films of Alfred Hitchcock, the music of Dmitri Shostakovich and Igor Stravinsky, and the paintings of Pablo Picasso³—from the public domain and to place them under U.S. copyright protection.⁴ For decades, these works had been freely available for public enjoyment and to inspire new artistic creation. Now, use of these works is conditioned upon payment of a potentially

[†] Online Executive Editor, *University of Pennsylvania Law Review*, Volume 162. J.D. & M.A. Candidate, 2014, University of Pennsylvania; B.M., 2008, University of Michigan. Sincere thanks to Erin Borek, D. Benjamin Thomas, and Volume 161 Associate Editors for their thoughtful and diligent edits, and to Kirsten Boreen for her guidance throughout the writing process.

¹ See Uruguay Round Agreements Act, Pub. L. No. 103-465, § 514, 108 Stat. 4809, 4976-80 (1994) (codified at 17 U.S.C. § 104A (2006)); see also *Golan v. Holder*, 132 S. Ct. 873, 877-78 (2012) (discussing the history of section 514).

² Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, S. TREATY DOC. NO. 99-27 (1986), 1161 U.N.T.S. 3 [hereinafter *Berne Convention*].

³ Marc Parry, *Supreme Court Takes Up Scholars' Rights*, CHRON. HIGHER EDUC. (May 29, 2011), <http://chronicle.com/article/A-Professors-Fight-Over/127700>.

⁴ See *Golan*, 132 S. Ct. at 900 (Breyer, J., dissenting).

exorbitant fee,⁵ which could make access to them prohibitively expensive for artists and arts organizations across the country.

In *Golan v. Holder*, the Supreme Court upheld section 514 against constitutional challenges under both the Copyright Clause and the First Amendment.⁶ *Golan* is the most recent (and the most drastic) example in a line of copyright decisions⁷ that display an alarming trend in the Court's jurisprudence—a willingness to prolong copyright protection with no ostensible regard for the goals of or constraints imposed by the Copyright Clause. Although *Golan* raised a number of complicated issues—including both the need for harmonization between the domestic laws of the United States and its international legal obligations, and the inherent tension between the First Amendment and the Copyright Clause—the Court made no real attempt to address them. Instead, the Court gave Congress virtual carte blanche to dispense copyright grants, even when doing so plunders millions of works from the public domain. The result not only places at risk the livelihood of thousands of artists and educators, but might also threaten the very existence of the American public domain.

Part I of this Note reviews the historical context that led to the passage of section 514. Part II examines the contours of the Court's opinion and Justice Breyer's dissent. Part III takes up and expands upon Justice Breyer's arguments, while Part IV considers the adverse implications of the decision and suggestions for future action.

I. THE BERNE CONVENTION AND CONGRESS'S PASSAGE OF SECTION 514

The Berne Convention for the Protection of Literary and Artistic Works (Berne Convention) is the “principal accord governing international copyright relations.”⁸ Under article 18, member nations agree to provide some level of copyright protection to works from other member nations whose copyright terms have not yet expired.⁹ The United States acceded to the Berne Convention in 1989, but did not grant retroactive copyright

⁵ See, e.g., Brief of Conductors Guild & Music Library Ass'n as Amici Curiae Supporting Petitioners at 11, *Golan*, 132 S. Ct. 873 (No. 10-545), 2011 WL 2470828 (noting that the price of the score of Shostakovich's *Preludes and Fugues Op. 87* has risen by a multiple of seven).

⁶ *Golan*, 132 S. Ct. at 889, 894.

⁷ See, e.g., *Eldred v. Ashcroft*, 537 U.S. 186, 222 (2003) (upholding the Copyright Term Extension Act, 17 U.S.C. § 302(a), which extended the terms of all copyrights, both future and existing, by an additional twenty years).

⁸ *Golan*, 132 S. Ct. at 877.

⁹ Berne Convention, *supra* note 2, art. 18.

protection to foreign works already in the public domain at that time.¹⁰ However, fearing retaliation by other Berne Convention members, the United States signed the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) in 1994, which demanded the implementation of the Berne Convention's first twenty-one articles.¹¹ Pursuant to TRIPS, Congress enacted section 514, which grants copyright protection to certain foreign works first published abroad between 1923 and 1989.¹² The vast majority of these works had been residing in the U.S. public domain at the time of section 514's passage.¹³

The newly copyrighted works fall into three categories: 1) works originating in countries with which the United States had copyright agreements at the time of the works' publication, but whose authors failed to satisfy formalities imposed by U.S. copyright law; 2) works originating in countries with which the United States did not have copyright agreements at the time of publication (including, most notably, the former USSR and China); and 3) certain sound recordings released after 1972.¹⁴ Section 514 grants works a copyright term equivalent to what they would have received had the works been "properly protected initially."¹⁵ Upon the passage of section 514, a mass of works "probably number[ing] in the millions," which had spent decades in the public domain, was suddenly placed under U.S. copyright protection.¹⁶ Section 514 does include an allowance for "reliance parties"¹⁷—those who had previously made use of the newly copyrighted

¹⁰ See Daniel Gervais, *Golan v. Holder: A Look at the Constraints Imposed by the Berne Convention*, 64 VAND. L. REV. EN BANC 147, 147-48 (2011).

¹¹ Agreement on Trade-Related Aspects of Intellectual Property Rights art. 9, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 108 Stat. 4809, 1869 U.N.T.S. 299, available at http://www.wto.org/english/docs_e/legal_e/27-trips.pdf [hereinafter TRIPS].

¹² *Golan*, 132 S. Ct. at 903-04 (Breyer, J., dissenting).

¹³ *Id.*

¹⁴ *Id.* at 878 (majority opinion); see also *id.* at 904 (Breyer, J., dissenting).

¹⁵ David L. Lange, Risa J. Weaver & Shiveh Roxana Reed, *Golan v. Holder: Copyright in the Image of the First Amendment*, 11 J. MARSHALL REV. INTELL. PROP. L. 83, 87 (2011).

¹⁶ Marybeth Peters, *The Year in Review: Accomplishments and Objectives of the U.S. Copyright Office*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 25, 31 (1996).

¹⁷ A reliance party is defined as "a person or business who has depended on the public domain status of the work in utilizing the work in a way that would, after restoration, be considered copyright infringement" and must have done so "both prior to and after the restoration date." *Reliance Parties*, COPYRIGHT.GOV, <http://www.copyright.gov/docs/reliance.html> (last visited Apr. 5, 2013).

works—that permits them to continue to utilize these works, but only until the copyright owner provides notice of intent to enforce his legal interest.¹⁸

II. *GOLAN V. HOLDER*: THE SUPREME COURT DECISION

A. *Factual and Procedural Background*

Conductor and music teacher Lawrence Golan, along with several other artists, musicians, and publishers who had relied on free access to works removed from the public domain by section 514, filed suit, claiming that section 514 both exceeded Congress's authority under the Copyright Clause and violated the First Amendment.¹⁹ Initially, the District Court for the District of Colorado entered summary judgment for the government,²⁰ but the Court of Appeals for the Tenth Circuit reversed and remanded with instructions to assess the First Amendment claim under intermediate scrutiny.²¹

On remand, the district court granted summary judgment for the plaintiffs on their First Amendment claim.²² This time, the Tenth Circuit reversed, holding that section 514 was narrowly tailored to advance the important government interest in protecting U.S. copyright holders' interests abroad.²³ The Supreme Court granted certiorari on both the Copyright Clause and First Amendment claims.²⁴

B. *The Majority Opinion*

In a 6–2 decision written by Justice Ginsburg, the Supreme Court affirmed the Tenth Circuit's decision, holding that in enacting section 514, Congress neither exceeded its authority under the Copyright Clause nor violated the First Amendment.²⁵ The Court relied on its 2003 decision, *Eldred v. Ashcroft*, in which it upheld the Copyright Term Extension Act (CTEA) in the face of similar constitutional challenges.²⁶

¹⁸ See 17 U.S.C. § 104A(c) (2006).

¹⁹ See *Golan*, 132 S. Ct. at 878.

²⁰ *Golan v. Gonzales*, No. 01-1854, 2005 WL 914754, at *19 (D. Colo. Apr. 20, 2005), *aff'd in part, remanded in part*, 501 F.3d 1179 (10th Cir. 2007).

²¹ *Golan*, 501 F.3d at 1197.

²² *Golan v. Holder*, 611 F. Supp. 2d 1165, 1176–77 (D. Colo. 2009), *rev'd*, 609 F.3d 1076 (10th Cir. 2010), *aff'd*, 132 S. Ct. 873 (2012).

²³ *Golan v. Holder*, 609 F.3d 1076, 1095 (10th Cir. 2010).

²⁴ *Golan v. Holder*, 131 S. Ct. 1600 (2011) (granting certiorari).

²⁵ *Golan*, 132 S. Ct. at 894. Justice Kagan recused herself from the case.

²⁶ See, e.g., *id.* at 884–85; see also *Eldred v. Ashcroft*, 537 U.S. 186, 208 (2003).

The Court first addressed Golan's claim that section 514 violated the Copyright Clause's stricture that copyrights be granted for only a "limited Time[]." ²⁷ Resting on *Eldred*'s conclusion that the Clause contained no "command that a time prescription, once set, becomes forever 'fixed' or 'inalterable,'" ²⁸ the Court rejected Golan's argument, reasoning that, as a textual matter, the Clause does not preclude the extension of copyright protection to works in the public domain. ²⁹ Thus, the Court held that section 514's protections were "no less 'limited'" than those provided by the CTEA. ³⁰ The Court neglected to mention that the CTEA had not withdrawn any works from the public domain.

The Court next rejected Golan's argument that section 514 thwarts the Copyright Clause's goal of "promot[ing] the Progress of Science" ³¹ because the law, which affects only *preexisting* works would therefore not incentivize the creation of new works. ³² Referring frequently to its *Eldred* opinion, the Court insisted that "[t]he creation of at least one new work . . . is not the sole way Congress may promote knowledge and learning." ³³ Rather, the Court contended that promoting the *dissemination* of existing works is equally sufficient to satisfy the Progress Clause's mandate. ³⁴ In facilitating a "well-functioning international copyright system," the Court believed section 514 would encourage the dissemination of both existing and future works. ³⁵

The Court dispensed with Golan's First Amendment argument with equal swiftness, reasoning, as it had in *Eldred*, that "[w]hen . . . Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary." ³⁶ The Court concluded that copyright's "traditional contours" were unaffected by section 514 because the idea/expression dichotomy and fair use defense—two of copyright's built-in safeguards ³⁷—were "undisturbed." ³⁸

²⁷ See *Golan*, 132 S. Ct. at 884-85; see also U.S. CONST. art. I, § 8, cl. 8 ("The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.").

²⁸ *Golan*, 132 S. Ct. at 884-85. (quoting *Eldred*, 537 U.S. at 199).

²⁹ *Id.*

³⁰ *Id.* at 885.

³¹ U.S. CONST. art. I, § 8, cl. 8.

³² See *Golan*, 132 S. Ct. at 887-88.

³³ *Id.* at 888.

³⁴ See *id.* at 888-89.

³⁵ *Id.* at 889.

³⁶ *Eldred v. Ashcroft*, 537 U.S. 186, 191 (2003); see also *Golan*, 132 S. Ct. at 890-91.

³⁷ See *infra* Section III.C.

The Court gave little weight to Golan's claim that his case presented First Amendment interests of a "higher order" than those in *Eldred*.³⁹ Golan argued that because the works affected by section 514 had been in the public domain prior to the retroactive grant of copyright, his reliance interest was much greater than the plaintiffs' interests had been in *Eldred*.⁴⁰ Justice Ginsburg rejoined that "nothing in the historical record, congressional practice, or [the Court's] own jurisprudence warrants exceptional First Amendment solicitude for copyrighted works that were once in the public domain," and cited numerous previous cases in which a work's public domain status was not viewed as a constitutional impediment to granting copyright protection.⁴¹

After disposing of both the Copyright Clause and First Amendment claims, the Court briefly turned to the international fairness concerns at the heart of the statute. Justice Ginsburg reasoned that section 514 mandates equal treatment of all foreign works of art, whereas previously, only certain works enjoyed copyright protection.⁴² The Court ultimately credited Congress's determination that "exemplary compliance" with the United States' international obligations was necessary to promote U.S. interests abroad,⁴³ concluding that it had "no warrant to reject the rational judgment Congress made."⁴⁴

C. Justice Breyer's Dissent

In a sharp dissent joined by Justice Alito, Justice Breyer argued that, in enacting section 514, Congress exceeded its powers under "any plausible reading" of the Copyright Clause because the statute withdrew material from the public domain without providing any countervailing benefit.⁴⁵ This inhibition of an important preexisting flow of information persuaded the dissenters that "the Copyright Clause, interpreted in the light of the First Amendment, [did] not authorize Congress to enact [the URAA]."⁴⁶

³⁸ See *Golan*, 132 S. Ct. at 890-91.

³⁹ *Id.* at 891.

⁴⁰ *Id.*

⁴¹ *Id.* at 891 & n.32; see, e.g., *Cox Broad. Corp. v. Cohn*, 420 U.S. 469, 495-97 (1975); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 479-84 (1974); *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966).

⁴² See *Golan*, 132 S. Ct. at 893.

⁴³ *Id.* at 894.

⁴⁴ *Id.* at 889.

⁴⁵ *Id.* at 903 (Breyer, J., dissenting).

⁴⁶ *Id.* at 912.

In addition, Justice Breyer emphasized that the removal of materials from the public domain would generate significant problems for reliance parties who had previously enjoyed free legal use of such materials.⁴⁷ These challenges could have been overcome had section 514 provided countervailing benefits (for example, stimulating the creation of new works). Justice Breyer found none. Because section 514 grants copyright protection only to works *already produced*, Justice Breyer concluded that "[section 514] provides no monetary incentive to produce anything new. Unlike other American copyright statutes from the time of the Founders onwards, including the statute at issue in *Eldred*, it lacks any significant copyright-related *quid pro quo*."⁴⁸

Justice Breyer was less confident that section 514 violated the First Amendment. He did, however, determine that Golan's First Amendment claim had enough substance to warrant the heightened scrutiny the majority declined to impose.⁴⁹

III. ANALYSIS AND CRITICISM

A. *The Government's Case and Congress's Complacency*

In its filings with the Court, the government argued that section 514 was necessary to ensure U.S. compliance with the Berne Convention.⁵⁰ If the Convention had in fact required legislation as sweeping as section 514, the Court likely would have been hamstrung and forced to uphold the statute. The Vienna Convention on the Law of Treaties,⁵¹ as well as the Supreme Court's own precedent,⁵² mandates that domestic law be interpreted to comply with international obligations. However, the Berne Convention did not demand such drastic congressional action—there were several alternatives

⁴⁷ See *id.* at 907 ("In practical terms, members of the public might well have decided what to say, as well as when and how to say it, in part by reviewing with a view to repeating, expression that they reasonably believed was, or would be, freely available.").

⁴⁸ *Id.* at 908.

⁴⁹ See *id.* at 907-08.

⁵⁰ See Brief for the Respondents at 11-12, *Golan*, 132 S. Ct. 873 (No. 10-545), 2011 WL 3379598.

⁵¹ See Vienna Convention on the Law of Treaties art. 27, May 23, 1969, 1155 U.N.T.S. 331 ("A party may not invoke the provisions of its internal law as justification for its failure to perform a treaty.").

⁵² See *Murray v. Schooner Charming Betsy*, 6 U.S. (2 Cranch) 64, 118 (1804) (holding that "an act of Congress ought never to be construed to violate the law of nations if any other possible construction remains").

that would have avoided placing the United States on such precarious constitutional footing, all of which the government failed to pursue.

Article 18(3) of the Berne Convention explicitly permits the negotiation of reservations to the article's retroactivity principle through special conventions concluded between member countries.⁵³ The TRIPS Agreement constituted one such "special convention," and in it, the United States successfully negotiated the omission of the Berne Convention's protection of moral rights.⁵⁴ Nevertheless, the United States made no attempt to obtain concessions relating to retroactive copyright protection, although there was no evidence that such a request would require a countervailing concession.⁵⁵ Indeed, other Berne Convention signatories—including Germany, Hungary, the United Kingdom, Australia, and New Zealand—elicited concessions with respect to retroactive protection in their countries and arranged for permanent accommodations for reliance parties.⁵⁶ The government's failure to pursue an easy reconciliation between the United States' foreign obligations and fundamental constitutional rights resulted in, as Justice Breyer put it, "a dilemma of the Government's own making."⁵⁷

And yet, even concessions were not necessary to avoid the extreme measures embodied in section 514. As Professor Gervais points out, the language of article 18 of the Berne Convention left Congress "wide latitude"—even without securing further concessions—to determine how far its grant of retroactive protection to works already in the public domain should extend.⁵⁸

A textual reading of article 18 suggests narrow retroactivity by specifying circumstances under which copyright of foreign works *shall not* be restored,⁵⁹ thereby implying that existing foreign works would be protected "*in some instances only* while also preserving most of the public domain."⁶⁰ And article 18(3) states that "the respective countries shall determine . . . the

⁵³ See Berne Convention, *supra* note 2, art. 18(3) ("The application of this principle shall be subject to any provisions contained in special conventions to that effect existing or to be concluded between countries of the Union.").

⁵⁴ See TRIPS, *supra* note 11, art. 9(1) ("Members shall not have rights or obligations under this Agreement in respect of the rights conferred under Article 6bis of th[e Berne] Convention or of the rights derived therefrom."); see also Berne Convention, *supra* note 2, art. 6bis (protecting an author's moral rights including the preservation of the integrity of his work).

⁵⁵ See Gervais, *supra* note 10, at 152.

⁵⁶ See *Golan v. Holder*, 611 F. Supp. 2d 1165, 1174 (D. Colo. 2009), *rev'd*, 609 F.3d 1076 (10th Cir. 2010), *aff'd*, 132 S. Ct. 873 (2012).

⁵⁷ *Golan*, 132 S. Ct. at 911 (Breyer, J., dissenting).

⁵⁸ Gervais, *supra* note 10, at 148.

⁵⁹ See Berne Convention, *supra* note 2, art. 18(2).

⁶⁰ Gervais, *supra* note 10, at 150 (emphasis in original).

conditions of application of this [retroactivity] principle."⁶¹ Finally, the Convention's legislative history displays an awareness of the existence of legitimate reliance interests,⁶² which militates against a broad grant of retroactive protection.

Thus, although the Berne Convention surely called for some level of retroactive protection, Congress went much further than the Convention required. In implementing section 514, Congress moved from one extreme—no retroactive protection for foreign works in the U.S. public domain—to the other—withdrawing millions of works from the public domain while reserving only a few rights to reliance parties.⁶³

There were less restrictive means of retroactive protection available to Congress. Instead of allowing copyright holders to name their price, royalties could have been capped at a reasonable amount.⁶⁴ In addition, Congress could have conditioned restored copyright protection on the provision of necessary registration information,⁶⁵ making it easier for prospective users of the work to locate copyright holders. Congress pursued neither option.

Because Congress declined to take advantage of less restrictive compliance methods permitted by the Convention, compliance with international obligations is no excuse either for the Court's holding or for its cursory treatment of Golan's legitimate Copyright Clause and First Amendment claims. As Justice Breyer noted, the Berne Convention cannot provide section 514 "with a constitutionally sufficient justification that is otherwise lacking."⁶⁶

B. *A Copyright Clause Without Force*

In fact, such a constitutionally sufficient justification was completely lacking in this case. The Copyright Clause contains internal limitations, including the requirements that a grant of copyright be for a "limited

⁶¹ Berne Convention, *supra* note 2, art. 18(3).

⁶² See 1 SAM RICKETSON & JANE GINSBURG, INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS: THE BERNE CONVENTION AND BEYOND online app. at 215 (2d ed. 2006), <http://www.oup.com/uk/booksites/content/9780198259466/15550026> (stating that the "interests of those who might have lawfully reproduced or performed foreign works without their authors' authorization" could be resolved by "domestic legislation").

⁶³ Gervais, *supra* note 10, at 158.

⁶⁴ See Golan v. Holder, 132 S. Ct. 873, 911 (2012) (Breyer, J., dissenting).

⁶⁵ See *id.* Such a provision would have gone a long way in combatting the orphan works problem. See *infra* Part IV.

⁶⁶ Golan, 132 S. Ct. at 912 (Breyer, J., dissenting).

Time[]” and that it “promote the Progress of Science.”⁶⁷ Section 514 satisfies neither. The effect of the Court’s endorsement of section 514 is, quite simply, to “free Congress from virtually any constraint that a long-standing student of the law of copyright might once have held to be implicit in the Copyright Clause.”⁶⁸

1. Unlimited “Limited Times”: The Court’s “Assault” on the Public Domain

Since the drafting of the U.S. Constitution, copyright terms in the United States have followed an unwavering course of progressive lengthening.⁶⁹ Even before *Golan*, Professor Ochoa observed that this trend had amounted to an “assault” by Congress on the public domain.⁷⁰ That assault is exemplified by three major pieces of copyright legislation enacted in the 1990s: the URAA; the 1992 Copyright Renewal Act, which made renewal automatic even though only ten to fifteen percent of copyright holders had previously sought to renew their copyright terms; and the CTEA, challenged in *Eldred*, which extended the terms of all copyrights by an additional twenty years.⁷¹

Because the CTEA extended copyright terms not only of future works, but of *existing* works as well, the Court’s holding in *Eldred* was particularly controversial as the Court had never before authorized a *retroactive* grant of copyright protection. However, unlike *Golan*, the *Eldred* decision dealt with the extension of copyright protection for *already copyrighted* works. The *Golan* Court took the implications of *Eldred* a significant step further, granting copyright protection *ex nihilo* to foreign works that had been in the public domain since their creation.

⁶⁷ U.S. CONST. art. I, § 8, cl. 8.

⁶⁸ See David Lange, *Golan, Again*, LEGALTALKNETWORK, at 7:25 (Mar. 1, 2012), <http://legaltalknetwork.com/podcasts/suffolk-law/2012/03/david-lange-golan-again/>.

⁶⁹ In 1790, the length of copyright was fourteen years, with an optional renewal for an additional fourteen years. In 1831, the length of the original term was increased to twenty-eight years and, in 1909, the renewal term was similarly extended. See Tyler T. Ochoa, *Is the Copyright Public Domain Irrevocable? An Introduction to Golan v. Holder*, 64 VAND. L. REV. EN BANC 123, 146 n.150 (2011) (citations omitted). The Copyright Act of 1976 established a unitary copyright term, beginning at the date of the work’s creation and extending fifty years beyond the author’s death. See *id.* at 127. Today, “copyright lasts for the life of the author plus seventy years—likely three or four generations for most works. Virtually no one will live to see the favorite works of their childhood enter the public domain” *Id.* at 146 (footnote omitted).

⁷⁰ *Id.* at 129.

⁷¹ See *id.* at 129–31. See also text accompanying note 26.

In concluding that *Eldred* was dispositive of Golan's claim that section 514 violates the "limited Times" restriction,⁷² the Court overlooked the important analytical distinction between *extending* copyright protection and *creating* it anew. Even if Congress deserves substantial leeway in determining how long copyright protection ought to last, it is not at all clear that Congress should be able to *initiate* protection whenever it chooses. As Golan argued, allowing Congress to do so "turn[s] a fixed and predictable period into one that can be reset or resurrected at any time, even after it expires."⁷³ After *Golan*, it appears that the "limited Times" restriction requires only that a grant of copyright have an *eventual* expiration date. Yet, because no one knows when the clock might start ticking, this constraint is little better than Congresswoman Mary Bono's ludicrous proposal that the length of copyright terms be "forever less one day."⁷⁴ As a result, many scholars agree that, by upholding section 514, the Court has rendered the "limited Times" requirement meaningless.⁷⁵

2. Section 514 Does Not Further the Goals of the Progress Clause

The preamble to the Copyright Clause states that Congress may grant copyright protection "[t]o promote the Progress of Science and useful Arts."⁷⁶ Throughout the twentieth century, most readers understood this as a mandate that copyright laws be crafted to encourage the creation of new works.⁷⁷ Earlier legislative history also supports this interpretation.⁷⁸

⁷² Golan v. Holder, 132 S. Ct. 873, 884 (2012).

⁷³ Brief for the Petitioners at 15-16, *Golan*, 132 S. Ct. 873 (No. 10-545), 2011 WL 2423674.

⁷⁴ 144 CONG. REC. H9952 (Oct. 7, 1998) (statement of Rep. Bono). In her famed testimony regarding the CTEA, Representative Bono, widow of Sonny Bono, commented, "Sonny wanted the term of copyright protection to last forever. I am informed by staff that such a change would violate the Constitution. . . . As you know, there is also [a] proposal for term to last forever less one day. Perhaps the Committee may look at that next Congress." *Id.*

⁷⁵ See, e.g., Ochoa, *supra* note 69, at 144 ("If Congress can validly take any work out of the public domain and put it back under copyright protection, . . . the 'limited Times' restriction . . . will be rendered a dead letter."); see also CATO INST., CATO HANDBOOK FOR POLICYMAKERS 395 (7th ed. 2009) ("Congress has made a mockery of [the 'limited Times'] requirement . . . by repeatedly and retroactively extending copyright terms."); Claire Fong, Golan v. Holder: Congressional Power Under the Copyright Clause and the First Amendment, 7 DUKE J. CONST. L. & PUB. POL'Y SIDEBAR 1, 17 (2011) ("If Congress can retroactively restore copyright to works in the public domain, it is difficult to imagine what it cannot do. Construing 'limited Times' in this way would rob the phrase of any meaning.").

⁷⁶ U.S. CONST. art. I, § 8, cl. 8.

⁷⁷ See Lange, *supra* note 68, at 6:05.

Reasoning along these lines, Golan argued that section 514 violates the Progress Clause because, by granting protection only to works already created—many of them almost ninety years ago—the law fails to provide *any* plausible incentives for the creation of new works.⁷⁹ However, the *Golan* majority emphatically held that stimulating the creation of new works is not the sole means by which Congress may “promote the Progress of Science.”⁸⁰ Rather, facilitating the *dissemination* of existing and future works also satisfies the mandate and the majority concluded that a “well-functioning international copyright system would likely encourage” just that.⁸¹

This reading of the Progress Clause is reasonable and is unsurprising given the Court’s holding in *Eldred*.⁸² However, despite the *Golan* majority’s contention, it is not clear that section 514 will, in fact, serve to encourage dissemination of copyrighted works.⁸³ Rather, section 514 seems much more likely to discourage dissemination of existing works, thereby failing to advance the goal of the Progress Clause. According to Professor Olson, although the ability to earn royalties does incentivize authors to promote their work, “these benefits are far outweighed by a general loss of access.”⁸⁴ Because many potential users of the works will not pay “[t]he above-market pricing that monopoly allows,”⁸⁵ the net result will be that “those who need

⁷⁸ See, e.g., H.R. REP. NO. 60-2222, at 7 (1909) (stating “[t]he Constitution . . . provides that Congress shall have the power to grant [copyrights]” because it “is believed to be for the benefit of the great body of people, in that it will stimulate writing and invention”).

⁷⁹ See Reply Brief at 4, *Golan v. Holder*, 132 S. Ct. 873 (2012) (No. 10-545), 2011 WL 4500811.

⁸⁰ *Golan*, 132 S. Ct. at 889.

⁸¹ *Id.* The Court was far too deferential to Congress’s determination. Professor Olson argues that while Congress is entitled to a degree of deference in deciding how best to promote the creation and dissemination of artistic works, “the Court cannot abdicate its responsibility to ensure that copyright laws actually [satisfy this objective].” David S. Olson, *A Legitimate Interest in Promoting the Progress of Science: Constitutional Constraints on Copyright Laws*, 64 VAND. L. REV. EN BANC 185, 191-92 (2011).

⁸² See *id.* at 888 (summarizing *Eldred* for the proposition “that the Copyright Clause does not demand that each copyright provision, examined discretely, operate to induce new works”).

⁸³ History has shown that even copyright owners themselves can egregiously miscalculate the effect that strict enforcement of copyright protections will have on the dissemination of their copyrighted works. In *Sony Corp. of America v. Universal City Studios, Inc.*, copyright owners sued to halt the manufacture and distribution of VCRs, based on the theory that the use of VCRs to record televised programs would impair the future value of their copyrights. 464 U.S. 417, 420 (1984). This prediction could not have been further off the mark: “[T]he VCR, which was once believed to be the death knell of the movie business[, instead arguably became] its savior, as consumers have proven willing to pay to buy or rent [movies]” Dan Ackman, *Movie Studios Get Hip With the Future*, FORBES.COM (Aug. 17, 2001), <http://www.forbes.com/2001/08/17/0817topnews.html>.

⁸⁴ Olson, *supra* note 81, at 193.

⁸⁵ *Id.*

[these works] for scholarly, educational, or cultural purposes"⁸⁶ will be forced to do without. The Progress Clause, as it was interpreted in *Golan*, is unlikely to impose any meaningful constraint on future copyrights.

C. *The First Amendment Claim: A Wasted Opportunity to Face the Tension Between the Copyright Clause and the First Amendment*

Before *Golan*, the Court had responded to First Amendment challenges to copyright legislation in a "cavalier and barely coherent fashion."⁸⁷ But *Golan*'s First Amendment claim was undeniably stronger than these earlier claims because section 514 applies to works that, for decades, had been freely available for artists to use as a basis for new artistic expression. Indeed, because *Golan* represented "the first time in history" that copyright legislation was challenged "directly and primarily" on First Amendment grounds,⁸⁸ it seemed that the Court could no longer avoid directly addressing the relationship between the Copyright Clause and the First Amendment. And even though they ultimately reached different conclusions, both the district court and the Tenth Circuit agreed that the First Amendment issues in the case merited heightened scrutiny.⁸⁹

Nevertheless, the Supreme Court persisted in dodging the First Amendment question, giving it "such short shrift . . . as to amount, once again, to no real opinion at all."⁹⁰ The effect of the Court's disinterest toward the legitimate First Amendment issues at stake in *Golan* is that copyright, "though not formally immune to First Amendment protection, [has become] immune in all but form."⁹¹

There is an intrinsic tension between the Copyright Clause and the First Amendment's protection of free expression that demands consideration. In its brief, the government admitted that "the very purpose of copyright protection is to limit the manner in which expressive works may

⁸⁶ *Golan*, 132 S. Ct at 903 (Breyer, J., dissenting).

⁸⁷ *Lange*, Weaver & Reed, *supra* note 15, at 111.

⁸⁸ *Id.* at 130.

⁸⁹ The district and circuit courts both applied intermediate scrutiny, which demands that a content-neutral regulation be upheld "if it advances important governmental interests unrelated to the suppression of free speech and does not burden substantially more speech than necessary to further those interests." *Golan v. Holder*, 611 F. Supp. 2d 1165, 1170 (D. Colo. 2009), *rev'd*, 609 F.3d 1076 (10th Cir. 2010), *aff'd*, 132 S. Ct. 873 (2012); *see also* *Golan v. Holder*, 609 F.3d 1076, 1083 (10th Cir. 2010).

⁹⁰ *Lange*, *supra* note 68, at 8:50.

⁹¹ *See id.* at 10:02.

be used,” and that limitations on expressive activity are “the intended and inherent effect of *every* grant of copyright.”⁹² Until *Eldred*, the Court had provided no indication as to how this tension might be relieved. There, Justice Ginsburg, writing for the Court, concluded that where “Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.”⁹³ She did not define “traditional contours,” but she did make clear that violating these “contours” was a prerequisite to the application of First Amendment scrutiny.⁹⁴

Initially, the Tenth Circuit in *Golan* reasoned that prior to the passage of section 514, “every statutory [copyright] scheme preserved the same sequence. A work progressed from 1) creation; 2) to copyright; 3) to the public domain” while, under section 514, “the copyright sequence no longer necessarily ends with the public domain: indeed it may begin there.”⁹⁵ Thus, the court concluded that a “traditional contour” of copyright law—the principle that works in the public domain typically remain there—had been altered, and it directed the court below to undertake a heightened First Amendment analysis.⁹⁶ The district court, on remand, found that section 514 was substantially broader than necessary to comply with U.S. treaty obligations and therefore could not survive intermediate scrutiny.⁹⁷ Upon its own application of intermediate scrutiny, the Tenth Circuit disagreed, concluding that section 514 was sufficiently tailored to the important government interests it served.⁹⁸

Based on the lower courts’ readings of section 514, it seemed the Supreme Court could no longer avoid a serious First Amendment analysis. The Court, however, defied expectations when it denied that section 514 altered the “traditional contours” of copyright protection.⁹⁹ Justice Ginsburg

⁹² Brief for the Respondents, *supra* note 50, at 34.

⁹³ *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003).

⁹⁴ *Id.*

⁹⁵ *Golan v. Gonzales*, 501 F.3d 1179, 1189 (10th Cir. 2007).

⁹⁶ *Id.* at 1196–97. Although removing works from the public domain and placing them under copyright protection was not unheard of prior to the passage of section 514, it had always occurred on a much smaller scale and, typically, under extenuating circumstances (for example, during a world war). *See, e.g.*, *Golan v. Holder*, 132 S. Ct. 873, 887 (2012) (noting that “in 1919 and 1941, Congress authorized the President to issue proclamations granting protection to foreign works that had fallen into the public domain during World Wars I and II,” respectively).

⁹⁷ *See Golan v. Holder*, 611 F. Supp. 2d 1165, 1174 (D. Colo. 2009), *rev’d*, 609 F.3d 1076 (10th Cir. 2010), *aff’d*, 132 S. Ct. 873 (2012) (stating that “Congress could have complied with the Berne Convention without interfering with a substantial amount of protected speech”).

⁹⁸ *Golan v. Holder*, 609 F.3d 1076, 1083 (10th Cir. 2010).

⁹⁹ *See, e.g.*, *Lange, Weaver & Reed*, *supra* note 15, at 125 (“Restoration under the URAA cannot be said to be *traditional* in any sensible meaning of that term.” (emphasis added)).

gave the narrowest possible reading to the term that she had left undefined for nearly a decade, holding traditional "contours" synonymous with the traditional "safeguards" of copyright, those being the idea/expression dichotomy and the fair use doctrine.¹⁰⁰ Because section 514 leaves these two safeguards intact, Justice Ginsburg concluded that the traditional contours of copyright had not been altered.¹⁰¹

The Court's definition of "traditional contours" is plainly underinclusive. The idea/expression dichotomy and fair use doctrines permit only limited public access to copyrighted works¹⁰² and can hardly be deemed to constitute the complete "traditional contours" of copyright. What about the originality requirement?¹⁰³ The "limited Times" requirement? Or, most pertinently, the heretofore well-established line between private ownership and the public domain?¹⁰⁴ Justice Ginsburg, who herself was responsible for coining the term "traditional contours" in *Eldred*, clearly backpedaled in *Golan*, defining the term so narrowly that the Court once again managed to circumvent a proper First Amendment analysis. Although scholars had been optimistic that *Golan* would be the "occasion for the adoption of a change in direction for the First Amendment,"¹⁰⁵ the decision had the opposite effect. Despite Golan's significantly stronger claims, the Court offered a nearly verbatim reiteration of the *Eldred* decision, further subjugating the First Amendment to the whims of what is fast becoming a completely unbounded doctrine of copyright.

¹⁰⁰ *Golan*, 132 S. Ct. at 890. The idea/expression dichotomy refers to the distinction between copyrightable expression and uncopyrightable facts and ideas. *Id.* The fair use defense provides "latitude for scholarship and comment," *id.* (citation and internal quotation marks omitted), but does not allow the use of a work in its entirety. *Lange, Weaver & Reed, supra* note 15, at 104.

¹⁰¹ *See Golan*, 132 S. Ct. at 890-91.

¹⁰² For example, under "fair use," an individual may be free to perform a few measures of a copyrighted musical score, though not the entire piece. *See Lange, Weaver & Reed, supra* note 15, at 104.

¹⁰³ *See* 17 U.S.C. § 102 (2006) (establishing that only "original works of authorship" are suitable subject matter for copyright protection); *see also* Fong, *supra* note 75, at 18 n.145 ("[B]ecause it is constitutionally required, the originality requirement certainly qualifies as a traditional contour of copyright protection.").

¹⁰⁴ *See* Brief of Heartland Angels, Inc. as Amicus Curiae in Support of Petitioners at 14, *Golan*, 132 S. Ct. 873 (No. 10-545), 2011 WL 2470833 (concluding that the dividing line between public and private ownership is "certainly one of those traditional contours [of copyright law]" and noting that "[s]ince its earliest days, copyright has made a clear distinction between what is protected and what is freely available to the public").

¹⁰⁵ *Lange, Weaver & Reed, supra* note 15, at 130.

IV. GOLAN'S FUTURE IMPLICATIONS

The Court's decision offers bleak prospects for artists, musicians, filmmakers, and the public at large. Most significantly, section 514 will limit the dissemination of historically and politically important works. For many schools and nonprofit organizations, it will likely render the use, study, or performance of these works impossible, "aggravating the already serious problem of cultural education in the United States."¹⁰⁶

The effects of the *Golan* decision will be felt rapidly and acutely throughout the artistic community. As a result of section 514, a copyright holder is free to charge for the use of his work. While the concept of usage fees is surely not novel for artists, section 514 is "uniquely disruptive" because it authorizes usage fees where previously there were none, thereby harming reliance parties who had depended on the ability to freely access affected works.¹⁰⁷ For many nonprofit groups that offer concerts, showings, and other public performances of newly protected works, these usage fees will be prohibitively expensive.¹⁰⁸ Moreover, groups that legally purchased copies of music or other reproductions while the relevant works were in the public domain may only continue to use these copies if they pay fees for each additional use.¹⁰⁹ In sum, "[t]hese new hurdles . . . limit the breadth of education for music students and deprive audiences of valuable artistic, intellectual, and emotional experiences."¹¹⁰

The newly imposed licensing fees will also affect derivative works—original works of art based on works whose copyrights have been restored under section 514.¹¹¹ While the initial creation of these works did not constitute copyright infringement because the source material was in the public domain at the time, creators of these works will now be forced to pay restored

¹⁰⁶ *Golan*, 132 S. Ct. at 905 (Breyer, J., dissenting).

¹⁰⁷ See Brief of Conductors Guild & Music Library Ass'n as Amici Curiae Supporting Petitioners, *supra* note 5, at 9.

¹⁰⁸ See *id.* at 7 ("Seventy percent [of surveyed members of the Conductors Guild and of the Music Library Association] are no longer able to perform works previously in the public domain—works performed regularly before the passage of Section 514—because those works are now under copyright protection.").

¹⁰⁹ See *id.* at 5.

¹¹⁰ *Id.*

¹¹¹ A derivative work is "a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted." 17 U.S.C. § 101 (2006).

copyright holders for their continued use. The only protection that section 514 offers is a stipulation that the required compensation be "reasonable."¹¹²

Section 514 also imposes significant administrative burdens on artists and arts organizations, including the costs of determining whether a work is subject to restored copyright, searching for the copyright holder, and negotiating a usage fee.¹¹³ These costs are particularly acute for "orphan works"—older and obscure works whose copyright owners are often impossible to locate.¹¹⁴ There are millions of such works¹¹⁵—which are frequently of significant historical and cultural importance despite having minimal commercial value¹¹⁶—and the cost of obtaining the requisite information can be substantial.¹¹⁷ These administrative costs could lead to a de facto moratorium on the use of orphan works.

Even more significant than the immediate consequences of *Golan* is the shadow the decision casts on the future of the American public domain. It may be that, because the *Golan* Court took such drastic steps to emaciate the public domain, the American public will be hesitant to rely on a work's public domain status in the future.¹¹⁸ Because *Golan* sets no explicit limit on the reach of its holding,¹¹⁹ artists will be understandably fearful that any

¹¹² *Id.* § 104A(d)(3).

¹¹³ *See Golan v. Holder*, 132 S. Ct. 873, 905 (2012) (Breyer, J., dissenting).

¹¹⁴ *Id.* Orphan works may exist, for example, because the copyright holder's contact information cannot be found; the copyright holder does not realize the work is copyrighted; or the copyright has been assigned to a new owner, whose identity is unknown. *See* JISC, IN FROM THE COLD: AN ASSESSMENT OF THE SCOPE OF 'ORPHAN WORKS' AND ITS IMPACT ON THE DELIVERY OF SERVICES TO THE PUBLIC 11-12 (2009), available at http://sca.jiscinvolve.org/wp/files/2009/06/sca_colltrust_orphan_works_v1-final.pdf.

¹¹⁵ *See id.* at 6.

¹¹⁶ *See* CATO INST., *supra* note 75, at 395.

¹¹⁷ *See* Brief of American Library Ass'n, Ass'n of College & Research Libraries, Ass'n of Research Libraries, Univ. of Mich. Dean of Libraries, Internet Archive & Wikimedia Found. as Amici Curiae Supporting Petitioners at 15, *Golan*, 132 S. Ct. 873 (No. 10-545), 2011 WL 2533007 (forecasting that the University of Michigan will spend more than \$1 million identifying owners of orphan works in the university's HathiTrust collection).

¹¹⁸ *See* Fong, *supra* note 75, at 19 (predicting that a holding similar to the Court's decision in *Golan* would "seriously undermine the integrity of the public domain in a way that could permanently stifle its use by the public").

¹¹⁹ For example, it is unclear whether, because section 514 grants retroactive copyright protection to foreign works that fell into the public domain due to their creators' failure to observe U.S. copyright formalities, domestic works in the public domain for the same reason should receive equivalent treatment. *See* Tyler Ochoa, *Comments on the Golan v. Holder Supreme Court Ruling* (Guest Blog Post), ERIC GOLDMAN: TECH. & MKTG. LAW BLOG (Jan. 23, 2012, 2:53 PM), http://blog.ericgoldman.org/archives/2012/01/ochoa_on_golan_1.htm ("I anticipate that owners of copyright in domestic works will now lobby Congress for the same advantage that foreign

public work they utilize might soon be “restored” to copyright by Congress, placing them in a financially compromising position. Now that the Court has established that Congress has wide latitude in removing previously uncopied works from the public domain, Congress could also theoretically grant retroactive protection to previously copyrighted public domain works whose copyrights have expired.¹²⁰

Golan does not necessarily sound the public domain’s death knell,¹²¹ but it has issued so broad a license to Congress that ostensibly there remain no principled constitutional safeguards against the public domain’s continued erosion. Professor Ochoa’s conclusion that the public domain now “exists only at the whim and forbearance of Congress and can be taken away from the public and privatized at any time”¹²² may not be an overstatement.

CONCLUSION

Golan presented the Court with a difficult task, forcing it both to address the sensitive matter of U.S. compliance with international legal obligations and to navigate the cumbersome constitutional issues presented by the constraints of the Copyright Clause and its interaction with the First Amendment. Although the holding itself is problematic, what is more troubling is both the majority opinion’s lack of depth and its failure to recognize the legitimate interests at stake. The Court engaged in little more than a hand-waving exercise, cavalierly extending *Eldred* to a vastly different realm of artistic works—those already in the public domain—without appreciation for the effects of its decision on the lives and livelihood of artists

copyright owners received [through section 514]: restoration of copyright for those works that are in the public domain for failure to comply with formalities such as copyright notice and renewal.”). A decision to extend copyright protection to such works would likely affect the public domain status of eighty-five percent of those works published in the United States between 1923 and 1963. *Id.*

¹²⁰ See Lange, *supra* note 68, at 6:58. Lamenting the future prospects for copyright law in the wake of *Golan*, Professor Lange concludes:

“Copyright has slipped its moorings after *Golan*. There is nothing in the Constitution now to constrain it, at least as far as the Supreme Court of the United States is concerned. The world of expression belongs to Congress, which belongs in turn to the NPAA or the RIAA and the copyright industries, and the devil take the hindmost.”

Id. at 12:05. This language also inspired the title of this Note.

¹²¹ Cf., e.g., Ochoa, *supra* note 69, at 144 (“Ultimately, what is at stake in *Golan* is nothing less than the entire corpus of works in the public domain, and even the entire concept of a public domain.”).

¹²² *Id.* at 146.

or for the fact that its decision, if taken to its logical conclusion, could threaten the very existence of the American public domain.

However, on a more optimistic note, the Court's March 2013 decision, *Kirtsaeng v. John Wiley & Sons, Inc.*¹²³—with Justice Breyer writing for the majority and Justice Ginsburg in dissent—demonstrates that all may not be lost for the future of copyright. Addressing the "first sale" doctrine,¹²⁴ which is obliquely related to the issues central to *Golan*, *Kirtsaeng* represents a rare and important refusal by the Court to bow to the demands of copyright holders. The decision endorses the lawful foreign purchase of English-language textbooks and their importation to and resale in the United States.¹²⁵ In declining to recognize a geographic limitation on the first sale doctrine,¹²⁶ the Court displayed a concern for the reliance interests of libraries, museums, and used-book dealers; an awareness of the practical infeasibility of tracking down foreign copyright holders to request permission to disseminate works that have been lawfully obtained; and, ultimately, a recognition that such inhibition of the free flow of artistic and literary works fails to satisfy the mandate of the Progress Clause.¹²⁷ Though the decision in *Kirtsaeng* by no means undoes the damage inflicted by *Golan*, perhaps it is an indication that the tide of the Court's copyright jurisprudence is finally beginning to turn.

Preferred Citation: Jessica W. Rice, Case Note, "*The Devil Take the Hindmost*": Copyright's Freedom From Constitutional Constraints After *Golan v. Holder*, 161 U. PA. L. REV. ONLINE 283 (2013), <http://www.pennlawreview.com/notes/5-2013/Rice.pdf>.

¹²³ 133 S. Ct. 1351 (2013).

¹²⁴ 17 U.S.C. § 109(a) (2006). The "first sale" doctrine provides that "the owner of a particular copy or phonorecord lawfully made under this title . . . is entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy or phonorecord." *Id.*

¹²⁵ See *Kirtsaeng*, 133 S. Ct. at 1356.

¹²⁶ *Id.* at 1358.

¹²⁷ See *id.* at 1364 ("How . . . are the libraries to obtain permission to distribute these millions of books [which were published abroad]? How can they find, say, the copyright owner of a foreign book, perhaps written decades ago? . . . And, even where addresses can be found, the costs of finding them, contacting owners, and negotiating may be high indeed. Are the libraries to stop circulating or distributing or displaying the millions of books in their collections that were printed abroad?").